

## **Remarks**

### **The Amendments**

As suggested in the Advisory Action, claims 74 and 75 have been amended to recite polynucleotide probes that consist of at least 300 contiguous nucleotides of the complete complement “of a polynucleotide having” a specified nucleotide sequence. Claims 74 and 75 have also been amended to delete the recitation of “a second polynucleotide.”

Claims 76, 77, 79-81, and 83-85 have been canceled.

None of the amendments introduces new matter or requires a new search. The amendments were not made earlier because Applicants believed that the amendments and arguments filed October 22, 2003 in response to the final Office Action were sufficient to overcome the rejections of the claims. Applicants believe these amendments place the claims in condition for allowance.

### **The Rejection of Claims 74-77, 79-81, and 83-85 Under 35 U.S.C. § 112, Second Paragraph**

Claims 74-77, 79-81, and 83-85 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 76, 77, 79-81, and 83-85 have been canceled. Applicants respectfully traverse the rejection of claims 74 and 75.

The Advisory Action asserts that the recitation of a “polynucleotide . . . that hybridizes . . . to the nucleotide sequence” is indefinite because polynucleotides hybridize to other polynucleotides, not to graphical representations of the nucleic acids that comprise polynucleotides, *i.e.*, sequences. Paper 17, page 2, lines 16-18. Claims 74 and 75 have been amended to recite that the polynucleotides consist of at least 300 contiguous nucleotides of “the

complete complement of a polynucleotide having the nucleotide sequence” shown in SEQ ID NO:11 (claim 74) or of the cDNA insert of plasmid pCRII-TMSP3 (ATCC Accession No. PTA-3433) (claim 75). The amendment corrects the asserted defect.

Applicants respectfully request withdrawal of this rejection.

The Rejection of Claims 74-77, 79-81, and 83-85 Under 35 U.S.C. § 112, First Paragraph


Claims 74-77, 79-81, and 83-85 are rejected as lacking adequate written description and enablement. Claims 76, 77, 79-81, and 83-85 have been canceled. Applicants respectfully traverse the rejection of claims 74 and 75.

The Advisory Action asserts that the recitation of a “second polynucleotide that hybridizes under stringent conditions” in claims 74 and 75 encompasses “a genus of polynucleotides of any function” that is not adequately described (paper 17, page 2, line 24) or enabled (paper 17, page 3, line 15) by the specification. To advance prosecution, claims 74 and 75 have been amended to delete the recitation of the second polynucleotide. Claims 74 and 75 now recite only subject matter that the U.S. Patent and Trademark Office acknowledges is both described and enabled.

Applicants respectfully request withdrawal of the written description and enablement rejections.

Respectfully submitted,

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